



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,900	03/25/2002	Bernd Meyer-Roscher	220245USOPCT	2780

22850 7590 03/08/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

HARAN, JOHN T

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/088,900

Applicant(s)

MEYER-ROSCHER ET AL.

Examiner

John T. Haran

Art Unit

1733

-- The MAILING DATE of this communication appears n th c ver sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 4/30/02 has been considered by the examiner.

### ***Specification***

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

the required "Sequence Listing" is not submitted as an electronic document on compact disc).

It is noted that the specification is divided into the various sections with headings.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite because the claim is directed to a process for bonding a polymer coated carrier to a substrate, yet there is no positive step of bonding in the claim. There is a step of contacting the polymer coated carrier with the substrate, however it is not clear if the contacting is actually bonding or if there is a later bonding step. It appears that the contacting step is the bonding step and it is suggested to amend the step to read - - bonding - - rather than "contacting".

Claim 12 is indefinite because it is unclear if the 0.05 to 10 wt% of at least one ethylenically unsaturated compound is part of the 0.1 to 30 wt% of polymerized monomer A or in addition to the polymerized monomer A. It appears from the specification that ethylenically unsaturated compound is part of polymerized monomer A (See specification, page 4, lines 33-35). It is suggested to amend the claim that the ethylenically unsaturated compound is part of monomer A.

Claim 22 is indefinite because on the one hand the claim states the polymer can be in a melted form, a solution, or an aqueous dispersion and then on the other hand it

Art Unit: 1733

requires removing solvent or water. If the polymer is in melted form then it does not appear there is a solvent or water to remove and hence the two requirements are contradictory. Clarification is requested.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10, 12-20, 22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kellen et al (U.S. Patent 4,737,559).

Kellen et al discloses a process for bonding a polymer coated carrier, such as a tape, to a moist substrate, the skin, in medical applications wherein a polymer is coated on a tape (carrier) in solution form, is dried to remove the solvent, is cross linked with ultra violet light and then bonded to skin (See abstract; Column 1, lines 7-10; Column 7, lines 25-49). The polymer is a free radically polymerized, UV cross linkable addition polymer comprising monomer A which is a acrylic or methacrylic acid ester of a non-tertiary alcohol with 1 to 14 carbons atoms (Column 5, lines 8-22), PX monomer which comprises an ethylenically unsaturated compound such as benzophenone in amount between 0.01 and 2 wt% (Column 4, lines 59-66; Column 6, lines 8-9), and B monomer such as methacrylamide and methacrylonitrile in an amount up to 25 wt% (Column 6, lines 15-29). It is clear that if PX monomer is between 0.01 and 2 wt% and B monomer

Art Unit: 1733

is up to 25 wt% than the remainder is A monomer and falls within the range between 50 and 99.85 wt%. Additionally since the B monomer of Kellen et al can be some of the cited examples of the claimed A monomer (see specification, page 5, lines 1-3 and claim 16), namely methacrylamide and methacrylonitrile, it is taken that they do not contain carboxylic acid or carboxylic anhydride groups and has a water solubility of more than 5 grams monomer per liter of water. Additionally skin is considered a substrate and skin is inherently moist. Kellen et al anticipates claims 10, 12, 13, 16, 18, 19, 20, 22, and 24.

Regarding claims 14 and 15, the claimed properties are inherent properties of the claimed adhesive and since Kellen et al teaches the claimed adhesive it is inherent the adhesive of Kellen et al has the desired K value and glass transition temperature.

Regarding claim 17, Kellen also teaches applying the polymer as a hot melt (Column 7, line 37).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06158006 or JP 03237181 in view of Kellen (U.S. Patent 4,737,559).

JP 06158006 and JP 03237181 both teach applying adhesive labels to refrigerated products wherein the adhesive comprises a polymer containing 4-12C alkyl methacrylate but is silent towards the polymer have all the claimed features.

The claimed free radically polymerized, UV cross-linkable addition polymer is known and is taught in Kellen. The polymer of Kellen is a free radically polymerized, UV cross linkable addition polymer comprising monomer A which is a acrylic or methacrylic acid ester of a non-tertiary alcohol with 1 to 14 carbons atoms (Column 5, lines 8-22), PX monomer which comprises an ethylenically unsaturated compound such as benzophenone in amount between 0.01 and 2 wt% (Column 4, lines 59-66; Column 6, lines 8-9), and B monomer such as methacrylamide and methacrylonitrile in an amount up to 25 wt% (Column 6, lines 15-29). It is clear that if PX monomer is between 0.01 and 2 wt% and B monomer is up to 25 wt% than the remainder is A monomer and falls within the range between 50 and 99.85 wt%. Additionally since the B monomer of Kellen et al can be some of the cited examples of the claimed A monomer (see specification, page 5, lines 1-3 and claim 16), namely methacrylamide and methacrylonitrile, it is taken that they do not contain carboxylic acid or carboxylic anhydride groups and has a water solubility of more than 5 grams monomer per liter of water.

One skilled in the art would have readily appreciated using a known alternate adhesive containing 2-14C alkylmethacrylate, such as the one taught in Kellen, in the method of JP 06158006 and JP 03237181, and to apply the adhesive of Kellen to the label of JP 06158006 and JP 03237181 and apply it to the refrigerated package using

Art Unit: 1733

the method taught in Kellen in the method JP 06158006 and JP 03237181.

Furthermore, one would be motivated to do so and have a reasonable expectation of success since the adhesive of Kellen and JP 06158006 and JP 03237181 are similar. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the adhesive of Kellen to a label and then bond it to a frozen substrate in the manner suggested in Kellen in the method of JP 06158006 and JP 03237181.

Regarding claims 14 and 15, the claimed properties are inherent properties of the claimed adhesive and since Kellen et al teaches the claimed adhesive it is inherent the adhesive of Kellen et al has the desired K value and glass transition temperature.

Regarding claim 17, Kellen also teaches applying the polymer as a hot melt (Column 7, line 37).

Regarding claims 11, 19, 21, 23, and 24, JP 06158006 and JP 03237181 teach the carrier is a label and the moist substrate is a refrigerated substrate.

### ***Conclusion***

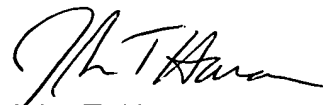
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(571) 272-1217**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "John T. Haran".

John T. Haran  
Examiner  
Art Unit 1733